

Application Serial No. 10/733,901
Amendment dated: September 30, 2005
Response to Office Action dated: July 6, 2005

Remarks/Arguments

These remarks are in response to the Office Action dated July 6, 2005. This reply is timely filed. At the time of the Office Action, claims 1-31 were pending in the application. Claims 3, 6, 12, 13, 16, 17, 19, and 25 were objected to as being dependent upon a rejected base claim, but the Examiner has indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1-31 were rejected under 35 U.S.C. §112, second paragraph. Claims 1-31 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Claims 1, 2, 4, 5, 7-11, 14, 15, 18, 20-24, 26-31 were rejected under 35 U.S.C. §103(a). The rejections are set out in more detail below. Claims 1, 3, 4, 7, 17, 24 have now been amended. Claim 25 has been cancelled. Claims 32-41 have been added. Please charge Deposit Acct. No. 50-2884 in the amount of \$325 for the one (1) additional independent claim and nine (9) additional dependent claims.

I. Allowable Subject Matter

Applicant notes with appreciation that the Examiner has indicated that claims 3, 6, 12, 13, 16, 17, 19 and 25 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, independent claim 24 has been amended to include the language of dependent claim 25. Independent claim 24 is now believed to be in condition for allowance. Likewise, claims 26-31, which depend from claim 24 are also now believed to be in condition for allowance.

II. Double Patenting

Claims 1-31 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims of copending Application No. 10/733,909. A terminal disclaimer in accordance with 37 CFR §1.321(c) is enclosed to overcome the foregoing rejections. Please charge the fee associated with the filing of a

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terminal disclaimer pursuant to Fee Code 2814 to Deposit Account No. 50-2884.
Accordingly, withdrawal of the double patenting rejection is respectfully requested.

III. Brief Review of Applicant's Invention

Prior to addressing the Examiner's rejections on the art, a brief review of applicants' invention is appropriate. The invention concerns a method and apparatus for securing a foundation form that is disposed on a moisture barrier membrane. The method includes the steps of positioning one end of a concrete form stake in a mating structure of a plug, penetrating the moisture barrier membrane with a tip end of the plug, and forming a seal between a flange extending around the periphery of the plug and the moisture barrier membrane.

The invention also concerns a prepared foundation site. (¶ [0019] Figs. 3A-3C.) The prepared foundation site includes a moisture barrier membrane that is disposed over portions of a foundation site. The prepared foundation site also includes a plurality of plugs that traverse the moisture barrier membrane and are embedded in the soil. ¶ [0020]. The plugs comprise an elongated body portion having a tip end, as well as a peripheral flange ¶ [0022] that is disposed adjacent to the moisture barrier membrane. The peripheral flange forms a seal with the moisture barrier membrane and surrounds an area where the plug's elongated portion traverses the moisture barrier membrane. For more detailed information regarding this aspect of the invention, please refer to ¶ [0019-0022].

IV. Claim Objections

Examiner had objected to some claims because of grammatical errors. In response, Applicants have amended claims 1, 3, 4, and 7 to correct these minor errors.

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V. Claim Rejections Under 35 USC §112, ¶2

Claims 1-31 were rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As an example, Examiner takes issue with independent method claim 1 for not positively claiming structural limitations "foundation form", "stake", "plug", and "moisture barrier membrane." These terms are inferentially referenced within independent method claims 1 and 14.

Applicants respectfully disagree with Examiners opinion that an inferential reference to apparatus limitations within a method claim should be positively cited. In most cases, a method performs upon or acts in conjunction with a product or apparatus. Applicants' method claims are constructed no differently. To avoid any confusion as to whether the claim is a method claim or an apparatus claim, it is common practice to inferentially refer to apparatus limitations in method claims. Furthermore, it is well established in the case law that method claims may inferentially reference apparatus limitations. For example, Ex parte Coburn, 87 U.S.P.Q. (BNA) 222 (Pat. & Tr. Office Bd. App. 1950) states the propriety of including apparatus limitations within method claims:

. . . we know of no authoritative holding to the effect that method claims must be free of apparatus limitations. On the contrary, it is well established that "mere reference to certain instrumentalities in process claims in describing performance of certain steps does not render claims improper, but limits them and makes them more definite."

Id. (quoting Ex parte Nelson and Cosby, 82 U.S.P.Q. (BNA) 115 (Pat. & Tr. Office Bd. App. 1949)). For this reason, Applicants believe that inferential referencing of the aforementioned structural limitations render Applicants' claims more definite, and not less definite as Examiner has noted.

In connection with positive recitation of apparatus limitations, the following in Ex parte Foreman, 326 O.G. 648 (1924) is also pertinent. It holds that "patentable novelty of method claims cannot be based on positive recitations of structural limitations

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included therein." Id. Therefore, it is not a requirement that the terms "foundation form", "stake", "plug", and "moisture barrier membrane" be positively recited in independent method claims 1 and 14. In view of the foregoing, claims 1 and 14 as well as all other pending method claims in the application overcome a 35 USC §112, ¶2 rejection.

VI. Claim Rejections Under 35 USC §103(a)

Claims 1, 2, 4, 5, 7-11, 14, 15, 18, 20-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,785,606 to Green ("Green") in view of U.S. Patent No. 2,978,840 to Tatsch ("Tatsch").

The Green invention discloses a mechanism for forming a side of a foundation. The mechanism comprises a base having a narrow vertically extending and horizontally elongated section and a relatively wide and horizontally elongated top section. The form is connected to the end(s) of one or more telescopic braces, and the other end(s) is/are held in place by stakes.

Significantly, Green does not disclose several important features that are presently recited in Applicants' independent claims 1 and 14. For example, claims 1 and 14 respectively include claim limitations directed to a penetrating step in which a plug penetrates a moisture barrier membrane. In contrast, Green does not disclose penetrating a moisture barrier with a plug. In fact, Green does not even disclose the existence of a moisture barrier membrane. Furthermore, what Examiner refers to as a plug is actually a telescopic brace 68 which does not penetrate the soil surface. (Green Fig. 3).

Applicants' claims 1 and 14 also respectively recite a sealing step whereby a seal is formed between the plug's peripheral flange and the penetrated moisture barrier membrane. Green is distinguishable from Applicant's invention in that Green also fails to disclose the formation of a seal between a flange extending around the plug's periphery and a moisture barrier membrane. The telescopic brace end in Green only serves to receive the stake and is not concerned with forming a seal since there is no moisture barrier to be traversed.

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The Examiner has also rejected claims 1 and 14 as being obvious in view of Tatsch. Tatsch discloses a method and an apparatus for positioning air conduits in an elevated configuration such that the conduits may be completely encased in concrete or masonry. An anchorage system of base plates, legs, and fastening components are used to support the air conduits in place. The base plates support the legs, which in turn are fastened to bands that support the conduit's weight. However, Tatsch is clearly distinguishable from Applicants' claimed invention since it also fails to disclose Applicants' step of penetrating a moisture barrier membrane with a plug. (Applicants' specification, Figs. 3A-3C). Instead, Tatsch discloses that the base plate/leg combination merely rests upon the moisture barrier membrane. (Tatsch, Figs. 2, 14, and 15). Furthermore, Tatsch does not teach Applicants' step of forming a seal between the plug and the moisture barrier membrane. Since there is no penetration of the moisture barrier membrane, there is no need for a seal as recited in claims 1 and 14 of Applicants' invention.

None of the references cited by the Examiner would suggest or motivate those skilled in the art to combine their features. Both Green and Tatsch inventions fail to disclose the penetrating and sealing steps recited in Applicants' claims 1 and 14. In view of the foregoing, Applicants' independent claims 1 and 14 are not obvious in view of the cited references. The remaining dependent claims are believed to be patentable at least by virtue of their dependence upon an allowable base claim.

Claims 24 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US Patent No. 5,564,232 to Callaway ("Callaway") or US Patent No. 6,202,368 to Wallace III ("Wallace"). Further, Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaway or to Wallace III. In view of the current amendment to independent claim 24 based on allowable subject matter, the obviousness rejection is now believed to be moot. Accordingly, Applicants believe that claims 24 and 26-31 are now in condition for allowance.

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VII. Conclusion

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. Nevertheless, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. In view of the foregoing remarks, Applicants respectfully request reconsideration and prompt allowance of the pending claims.

Respectfully submitted,

Date

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